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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/096,811	06/12/1998	YU-HAI MAO	ESS.P002	2246
25700	7590	06/02/2005	EXAMINER	
FARJAMI & FARJAMI LLP 26522 LA ALAMEDA AVENUE, SUITE 360 MISSION VIEJO, CA 92691			BOCCIO, VINCENT F	
			ART UNIT	PAPER NUMBER
			2616	

DATE MAILED: 06/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/096,811

Applicant(s)

MAO ET AL.

Examiner

Vincent F. Boccio

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(e). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-10 and 16-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-10 and 16-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 2616.

Response to Arguments

1. Applicant's arguments filed 2/7/05 have been fully considered but they are not persuasive.

{A} In re page 7, applicant states, "Aotake, there is no browsing the content", as required. In fact, the word "browse", in any of its forms. All that is taught is selecting."

In response the primary examiner would like applicant to explain Fig. 5 of applicant specification, step 506, "SWITCH FROM A BROWSER (e.g., browser, menu, search engine, etc.) mode to video mode", based on Fig. 5, one example of a Browser is a MENU.

Fig. 20 of Aotake, is a menu with three items for a user to browse and select.

Can applicant confirm or deny for the record that the Browser does provide items to choose from or not, such as a menu, as shown in Fig. 20.

There fails to be any language that modifies the browser menu screen to be distinguishable over the art, as even applicant shows that a browser in the form of a menu, as the used prior art.

Further in accord to col. 3, Fig. 20, states, "Fig. 20 illustrates an example of a menu", which those skilled in the art realize that a user views or browses the choices and chooses one to play, when selected goes into the video mode, from the browse or menu mode, as claimed.

Furthermore, even in accord to applicant's disclosure at page 9, "browser mode includes display of any data and program format except video playback. Hence, it includes browser, menu, or search engine modes, which display text", and other", therefore, in its broadest form the Browser can provide a menu of text wherein the user browses or views and selections and chooses from the menu or browser screen, displayed text, based on the desired and thereafter goes into video mode, the claims are not deemed distinguishable over the art in view of not defining or claiming the differences.

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{B} In re page 7, applicant further states, "it is a list in memory that is being selected. The content of the disk is not being browsed as required by the claim."

In response again the examiner refers to Fig. 5 of applicant own disclosure, "LOAD A BROWSER DATA into memory" select a clip to play, switch from the Menu Browser mode, being a menu, therefore, is selecting related data to the content, thereby selecting the content, wherein Aotake's menu is selecting a video and thereafter switching, to video mode based on the selection.

It is further noted that the menu or browser as claimed, there is no figure to identify specifically what is presented to the user and the claims fails to be distinguishable from a menu to browse and select from, in view of the broad claim language.

{C} In re page 8, applicant states, "Even if browsing the content", were taught by AOTAKE, that reference still cannot be used as a based reference in a 103, because there is no, reserving a portion of memory other than the CD-ROM disk for storing a return address in the reserved portion of the memory."

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

{D} In re page 8, applicant states, even though a memory is used "This is not "reserving a portion of the memory".

Further, in accord to the last action the examiner provides a teaching Yasuda, which uses a memory or is adapted to utilize a record position memory, allowing a user to stop and resume where left off, therefore at the time of design of the system, prior to powering the system up, the system clearly has been designed to and adapted to perform this function of storing a return address, which is deemed to anticipate, that a memory has been reserved, to hold the return address, as designed and intended operation.

Any system, which has a function to store in a memory, the memory is deemed reserved at the design stage, for that intended use prior to use.

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{E} In re pages 9-10, applicant basically states that, "no suggestion in either of Aotake or Yasuda for combining Yasuda and Aotake".

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Yasuda does teach storing a return address for resuming and provides the advantage of allowing resuming after stopping, therefore, as those skilled in the art would understand, that the user can resume where left off, rather than start from the beginning every time the user stops reproduction, if the left off location has not been in the memory which is adapted and therefore, reserved for that purpose, as is deemed clear to those skilled in the art.

The claims are not deemed distinguishable over the prior art in view of the claims as presented.

The examiner suggests amending the claims to more represent differences from the prior art, utilizing features that are clearly not recited in the claims and not disclosed by the prior art of record, in accord to Fig. 3, it seems clear applicant can narrow the claims to indicate the Browser provides images representative of the content, such as GIF and JPEG, HTML, based on Fig. 3, at best can be said that images representing contents can be provided to the user in a Browse mode.

The examiner suggests that claiming that the Browser is HTML based document based, rather than broadly claiming the Browser and/or Images of the content are being browsed by the user to select from, narrowing in this direction, if amended properly would help to be distinguishable, over the applied art of record and possible any art further uncovered in future searches.

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Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 1, 3-10 and 16-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aotake et al. (US 5,687,160) in view of Yasuda et al. (US 5,999,694) and Terashima et al. (US 5,142,521).

The examiner incorporates by reference the last action against the claims.

Conclusion

1. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Contact Fax Information


Any response to this action should be faxed to:

(703) 872-9306, (for communication intended for entry)

Contact Information

Any inquiry concerning this communication or earlier communications should be directed to the examiner of record, Monday-Tuesday & Thursday-Friday, 8:00 AM to 5:00 PM Vincent F. Boccio (571) 272-7373.

Primary Examiner, Boccio, Vincent
5/30/05


VINCENT BOCCIO
PRIMARY EXAMINER